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withdrawn as the claims are patentable over the cited art for the reasons discussed below. In particular, the cited art fails to disclose or suggest a "socket insert" that is "deformed" to retain engagement with an electrical conductor as recited in the independent claims. The cited art further fails to disclose a "tubular" socket insert as recited in independent Claims 1, 21 and 22.

I. The Section 102 Rejection

Claims 1, 6-7, 13-14, 17 and 20-22 stand rejected under 35 U.S.C. § 102(a) as being anticipated by United States Patent No. 5,494,462 to Auclair ("Auclair"). The Office Action asserts that, among other things, Auclair discloses "a socket insert fitting (12) within the tubular socket (22) ... wherein the socket insert is tubular (12)." (Office Action, p. 2).

Under 35 U.S.C. § 102, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (citations omitted) (emphasis added).

A finding of anticipation further requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). Thus, anticipation requires that

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a single prior art reference disclose each and every element of the anticipated claim.

As noted above, the Office Action relies on the ground rod 12 of Auclair as teaching the claimed "socket insert." As would be understood by those of skill in the art and as illustrated in Auclair, the ground rod 12 is a solid rod electrically conductive structure that is, presumably, metal. The ground rod 12 is also illustrated as having a significantly greater diameter than the ground wires 14 to which it is clamped by the ground rod clamp 10. (Auclair, FIG. 1, Col. 2, lines 29-32). Thus, if anything in the ground rod clamp 10 of Auclair deformed, it would be the wires 14, not the rod 12. The Office Action fails to even discuss these recitations of the independent claims. (*See, e.g.*, Claim 1, "the socket insert is tubular and is adapted to be deformed by clamping means into retaining engagement with the electrical conductor" (emphasis added)). For at least the foregoing reasons, Applicant respectfully submits that independent Claims 1, 13, 21 and 22, and the claims that depend therefrom, are not anticipated by Auclair and the rejections of Claims 1, 6-7, 13-14, 17 and 20-22 should be withdrawn for at least these reasons.

Claims 1, 14, 21 and 22 further recite that the socket insert is either a "tubular member" (Claims 1 and 21) or is "substantially tubular" (Claims 14 and 22). Contrary to the assertion of the Office Action, the ground rod 12 of Auclair, while cylindrical, is not tubular. As defined, for example, in the pertinent portion of the American Heritage College Dictionary, a "tube" is a "hollow cylinder" or a "cylindrical container." (American Heritage College Dictionary, p. 1452, copy attached). Thus, the solid ground rod 12 of Auclair is not "tubular" and the rejections of Claims 1, 14, 21 and 22 and the claims that depend therefrom should also be withdrawn for at least these additional reasons.

II. The Section 103 Rejections

Claims 2, 10 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Auclair. Claims 3-4, 9, 11, 15-16 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Auclair in view of U.S. Patent No.

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4,687,273 to Pranch ("Pranch"). Claims 5, 12 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Auclair in view of U.K. Patent No. 2,219,442 to Krill ("Krill"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Auclair in view of U.S. Patent No. 5,494,462 to Polidori ("Polidori").

To establish a prima facie case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claim, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). To support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The Court of Appeals for the Federal Circuit has also stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, **would have selected these components for combination in the manner claimed.** *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Respectfully, as will be discussed below, the Official Action fails to meet the requirements for a showing of obviousness under § 103.

As an initial matter, the rejected claims are patentable at least for the reasons discussed above with reference to the anticipation rejections as none of the other cited references disclose the recitations of the present invention not found in Auclair. In addition, various of the asserted motivations to combine presented in the Office Action are unsupported by the cited references. For example, with reference to

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Pranch, the Office Action asserts that the motivation to include "at least one of a castellated or corrugated profile" would be "to improve the mechanical strength of the retaining engagement." (Office Action, p.4). However, there is no reason to believe adding such a profile to the ground rod 12 of Auclair would improve mechanical strength. In fact, given the multiple radius design of the opening 24 of Auclair and the purpose for the multiple, different radius proportions, one of skill in the art would clearly not be motivated to vary the smooth cylindrical profile of the ground rod 12. Furthermore, the ground rod 12 would, presumably, not necessarily even be sold with the ground rod clamp 10. Accordingly, the rejections based on Pranch should be withdrawn for at least these additional reasons.

Similarly, with regard to the rejections based on Krill, there is no support for the assertion that Auclair would be modified to add an internal surface with serrations or tooth-like formations "to make the connector able to retain conductors in an inside surface more efficiently." (Office Action, p. 4). As discussed with reference to Auclair above, there is no "inside surface" of the ground rod 12 of Auclair that could be modified by one of skill in the art. Accordingly, the rejections based on Krill should be withdrawn for at least these additional reasons.

III. The Dependent Claims Are Separately Patentable

The dependent claims are all patentable by virtue of the patentability of the independent claims from which they depend as discussed above. In addition, various of the dependent claims are separately patentable. For example, separate grounds of patentability for various of the dependent claims based on the lack of motivation for the combination of references relied on in the rejections have already been discussed above with reference to the Pranch and Krill references. In addition, based on Applicant's review, Krill does not appear to disclose a socket insert having an internal surface with serrations or tooth-like formations. The Office Action states that "Krill disclosed a connector having an internal surface of a tubular socket insert (7) having at least one of serrations (15) or tooth-like formations (15)." (Office Action, p. 4). In

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fact, Krill states that "two adjacent parallel ducts 7 lying side by side are provided, which are formed each by two groove-shaped recesses 8, 9 and 10, 11, respectively, in the respective jaws 1, 2." (Krill, p. 4). Thus, item 7 of Krill is a recess, not an insert and it can have no internal surface, with or without serrations. Accordingly, the rejections of Claims 5, 12 and 18 should also be withdrawn for at least these additional reasons.

Claims 17 and 22 are also separately patentable based on the recitations therein related to positioning of the electrical conductor "within" the tubular socket insert. Contrary to the assertion of the Office Action, Auclair simply does not disclose "the electrical conductor (14) being received within the tubular socket insert (12)" or provide the recited relative positioning of the different parts of the claimed connector in Claims 17 and 22. (Office Action, p. 3). As discussed above, the ground rod 12 of Auclair is a solid rod and nothing can be placed within the ground rod 12. The wires 14 are clearly illustrated in Figure 1 of Auclair as adjacent an outer surface of the ground rod 12. Accordingly, the rejections of Claims 17 and 22 should also be withdrawn for at least these additional reasons.

IV. Conclusion

Applicant respectfully submits that, for the reasons discussed above, the references cited in the present rejections do not disclose or suggest the present invention as claimed. Accordingly, Applicant respectfully requests allowance of all the pending claims and passing this application to issue.

Respectfully submitted,



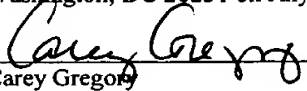
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Version With Markings to Show Changes

In the Claims:

7. (Twice Amended) A connector as claimed in Claim 1, wherein the clamping means comprises at least one clamping bolt held in respective threaded bores in the connector body such that the at least one clamping bolt extends into the socket so as to clamp, via the socket insert, [a connector] an electrical conductor inserted in the socket against an opposing surface of the socket.